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Claim Rejections – 35 U.S.C. § 103

Claims 1-42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Seigel in view of Walker. Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. Manual of Patent Examining Procedure §2142. The first requirement is that the combination must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second requirement is that there must be a suggestion or motivation to combine the references. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third requirement is that there must be a reasonable expectation of success in the combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the proposed combination of Seigel and Walker fails to meet a single requirement of a prima facie case of obviousness. As such, reconsideration of claims 1-42 is respectfully requested in light of the present remarks.

To establish a prima facie case of obviousness the combination of Seigel and Walker must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 claims a "method for facilitating customs planning and clearance" including "creating in an international customs server, in response to a signal communicated through a client device coupled for data communications through at least one internet connection to the international customs server, a customs planning record; creating, in dependence upon the customs planning record, a customs declaration form for a destination country; and submitting the customs declaration form to a customs declaration forms database for the destination country." In stark contrast to independent claim 1, Seigel discloses personalizing, customizing and distributing geographically distinctive products and travel information over the internet. Seigel, abstract. Walker discloses an electronic commercial environment for the processing of an import/export transaction between a buyer and a seller. Walker, paragraph 0045. Neither Seigel nor Walker, alone or in combination, disclose facilitating customs planning and clearance, an international customs server, creating customs

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planning records, or submitting the custom declaration forms. Because the combination of Seigal and Walker do not teach each and every element of independent claim 1, the combination of Seigal and Walker cannot establish a prima facie case of obviousness. The rejection should be withdrawn.

To establish a prima facie case of obviousness there must also be a suggestion or motivation to combine Seigal and Walker. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The rejection itself demonstrates that there is no suggestion or motivation to make the proposed combination of Seigal and Walker. The rejection states:

"It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Seigal's system and method for personalizing, customizing and distributing geographically distinctive products and travel information with Walker's computer implemented trade system in order to provide an automated efficient uniform travel system to a busy traveler."
Office Action Dated March 4, 2004, paragraph 1.

Applicant claims a "method for facilitating customs planning and clearance" not an automated efficient uniform travel system as proposed in the office action. There is no suggestion or motivation to combine Seigal and Walker to create a travel system, because in fact, independent claim 1 claims a "method for facilitating customs planning and clearance." As such, the proposed combination itself teaches away from Applicants claims and therefore does not establish a prima facie case of obviousness. The rejection should be withdrawn.

To establish a prima facie case of obviousness there must also be a reasonable expectation of success in the combination of Seigal and Walker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The proposed combination of Seigal and Walker will not work to facilitate customs planning and clearance as claimed in independent claim 1. The rejection itself demonstrates that the proposed combination of Seigal and Walker will not work. The rejection states:

"It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Seigal's system and method for personalizing, customizing and distributing geographically distinctive products and travel

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information with Walker's computer implemented trade system in order to provide an automated efficient uniform travel system to a busy traveler." Office Action Dated March 4, 2004, paragraph 1.

Applicant claims a "method for facilitating customs planning and clearance" not the automated efficient uniform travel system proposed by the office action. That is, the proposed combination of Seigel and Walker works to create a travel system. The proposed combination does not however work to create a "method for facilitating customs planning and clearance" as claimed in claim 1. As such, the proposed combination does not establish a prima face case of obviousness. The rejection should be withdrawn.

Claims 15 and 29 claim system and computer program products for facilitating customs planning and clearance corresponding to method claim 1. For the same reasons that the combination of Seigel and Walker fails to establish a prima face case of obviousness of claim 1, the proposed combination also fails to establish a prima face case of obviousness of claims 15 and 29. More particularly, the proposed combination does not teach each and every element of claims 15 and 29, there is no suggestion or motivation to make the proposed combination, and the proposed combination does not work. As such, claims 15 and 29 are patentable and should be allowed.

Dependent claims 2-14, 16-28, and 30-42 depend from independent claims 1, 15, and 29 respectively and include all of the limitations of the claims from which they depend. As shown above, the proposed combination of Seigel and Walker fails to establish a prima facie case of for facilitating customs planning and clearance. Because claims 1, 15 and 29 stand, dependent claims 2-14, 16-28, and 30-42 stand as well. As such, claim 1-42 are patentable and should be allowed.

Conclusion

The proposed combination of Seigel and Walker fails to establish a prima face case of obviousness because the proposed combinations does not teach each and every element

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of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants' claims are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-42.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: 4/27/04

By:

Respectfully submitted,



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